



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,471	03/21/2001	Karl Lang	ME-32	3608

7590 11/30/2004
Friedrich Kueffner
317 MADISON AVENUE
SUITE 910
New York, NY 10017

EXAMINER

LUDLOW, JAN M

ART UNIT PAPER NUMBER

1743

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,471

Applicant(s)

LANG ET AL.

Examiner

Jan M. Ludlow

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1743

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3-5, 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao et al.

Rao teaches an analytical device having a temperature controlled (col. 3, lines 40-65) vial storage area 14, thermal equilibration area 16, bar code reader 58 for

reading vial bar codes, and analytical modules 24, 26 for aspirating sample and forwarding to, e.g., a gas chromatograph. The temperature control and/or optical bar code reader constitute the instant energy source. The modules are adapted to mate with the base and only one or both can be provided (col. 4, lines 58-65). Module mounting can be achieved by providing holes and screwing the module to the base (col. 4, line 66- col. 5, line 4). Computer control is provided, including keyboard input (col. 8, lines 9-24, Fig. 11). The vial storage and movement may be provided by a carousel (col. 4, lines 18-20).

Rao fails to explicitly teach a turntable embodiment.

It would have been obvious to provide vial storage and movement with a turntable and drive in order to provide the alternative vial storage taught by Rao. With respect the right-angled flange, it would have been obvious to provide a base under the turntable analogous to the structure labeled 14 in Figure 1, the perpendicular wall constituting the other portion of the right angle. With respect to analytical programming, it is the examiner's position that analytical GCs inherently use analytical programming to locate and identify component peaks; alternatively, it would have been obvious to provide analytical programming to determine components in the peaks as was known in the art.

5. Claims 1, 3-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riley et al in view of Rao.

Riley teaches a device having a base supporting modules 4a-4f in trays, i.e., shallow "U" shaped support surface devices (col. 6, line 23). Vials are passed by the

Art Unit: 1743

modules on a conveyer. The vials have bar codes and an identification unit is provided (col. 5, line 40). The modules have moveable sampling arms 41, 47, 48 (fig. 5). A microprocessor is used to control operation of the apparatus, including skipping certain tests for certain samples, and read and store analytical results (col. 5, lines 59-68; col. 13, lines 10-23).

The teachings of Rao are given above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a carousel and drive in place of the conveyor belt of Riley in order to provide a known alternative to rectangular storage and movement device as taught by Rao. It would have been further obvious to attach the modules to the base, as by screws or other attachment means in order to provide secure attachment as taught by Rao. It would have been obvious to provide energy (e.g., thermal control) to the samples in the carousel in order to maintain them at a desired temperature prior to analysis as taught by Rao. It would have further been obvious to provide a keyboard to the microprocessor as taught by Rao for its known purpose of inputting information to a processor.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Lillig additionally teaches modular analyzers.
8. Applicant's arguments filed August 27, 2004 have been fully considered but they are not persuasive.

Applicant argues that Rao does not teach a drive, but Rao teaches that the vial storage area can be "a vial-carrying rotating carousel or other known automated vial advancement device" (col. 4, lines 17-21), which rotation would inherently be provided by a drive mechanism as was known in the art. Applicant argues that Rao doesn't teach an analytical instrument, but on page 2, line 1, of the instant disclosure, a "tube" is disclosed as constituting an analytical device as described herein, and Rao teaches a tube inserted into the sample for passing a sample to an analytical device. Applicant argues that Rao does not teach the instant mounting, but fails to address the rejection, repeated here for applicant's convenience: "The modules are adapted to mate with the base and only one or both can be provided (col. 4, lines 58-65). Module mounting can be achieved by providing holes and screwing the module to the base (col. 4, line 66-col. 5, line 4)." The holes and screws are the non-destructive releasable connectors of the instant claim. Applicant argues that the examiner has admitted that Rao does not teach a turntable, but then states that a turntable would have been obvious without showing where Rao et al teach such a construction. This statement is simply not true. For applicant's convenience, the examiner will once again repeat the pertinent portion of the rejection: "The vial storage and movement may be provided by a carousel (col. 4, lines 18-20).

Rao fails to explicitly teach a turntable embodiment.

It would have been obvious to provide vial storage and movement with a turntable and drive in order to provide the alternative vial storage taught by Rao."

Art Unit: 1743

A carousel is a turntable, and Rao explicitly teaches that a carousel could be used. It would therefore be obvious to use one.

Applicant argues that Riley teaches only that the modules are side by side and does not teach mounting fewer than all the modules shown. However, Riley teaches that fewer than all modules can be used (col. 13, lines 15-20), and Rao teaches that fewer than all modules can be mounted. Further, there is no criticality in Riley as to the order of the modules, and each module is shown as being substantially the same, so one of ordinary skill would understand that any module could be mounted in any slot.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

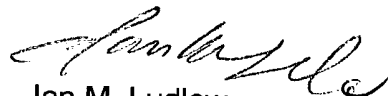
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (571) 272-

Art Unit: 1743

1260. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jan M. Ludlow
Primary Examiner
Art Unit 1743

Jml

November 29, 2004